

REMARKS

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the present specification and claims and the following remarks.

Status of the Claims

In the present Reply, claims 1, 15, 18 and 20 have been amended. Also, claims 14 and 19 have been canceled without prejudice or disclaimer of the subject matter contained therein. This makes claims 1-13, 15-18 and 20 as pending in the present application.

No new matter has been added by way of these amendments because each amendment is supported by canceled claims 14 and 19 as well as the present specification at page 14, lines 2-4, page 22, lines 1-3 and page 23, lines 15-19.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all objections and the rejection and allow the currently pending claims.

Abstract

The Abstract is objected to for having too many words (see paragraph 1, page 2 of the Office Action). The Abstract has been amended as shown herein to reduce the number of words such that it is now less than 150 words. With these changes, withdrawal of this objection is respectfully requested.

Specification

The Examiner has objected to parts of the present specification due to typographical and/or grammatical errors (see paragraph 2 of the Office Action). Applicants herein submit a substitute specification. The issue here, as stated in the Office Action, is that some words are so close to each other that two words may appear as one word. Thus, the submitted substitute specification has a different font (from "Courier New" to "Times Roman") to eliminate such improper spacing between words. No new matter has been added.

Reconsideration and withdrawal of this objection are respectfully requested.

Issues under 35 U.S.C. § 103(a)

Claims 1-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over JP '501 (Honda *et al.*; JP 2001004501 A) in view of JP '115 (Honda *et al.*; 2000163115 A) or EP '335 (EP 1 219 335 A1) (see paragraphs 3-5 of the Office Action). EP '335 is in the English language wherein the Examiner states it claims priority to the secondary reference of JP '115.

Applicants respectfully traverse and reconsideration is based on the following remarks. Overall, Applicants do not concede that a *prima facie* case of obviousness has been established.

The Present Invention

Applicants respectfully refer the Examiner to pending claims 1, 15, 18 and 20 as presented herein. As can be seen, these claims are directed to a cylindrical shape of the molded body (i.e., the filter) as well as the hydrophobic material being retained in the molded body in a certain direction. More specifically, the shape of the molded body is limited to a cylinder having one

closed end (see also the present description at page 14, lines 2-4 and page 22, lines 1-3). Also, the hydrophobic material is retained mainly in a direction of the inner circumferential side to the thickness direction of the molded body (see the present specification at page 23, lines 15-19).

Distinctions over JP '501 and EP '335/JP '115

The cited primary reference of JP '501 discloses a filter for selecting and collecting a chlorinated organic compound contained in a fluid from the fluid. The filter in the cited JP '501 reference has a fluid-permeable body that has two layers (71,72). The first layer (71) is composed of fibers bound by cellulose or organic binder. The second layer (72) has an activated carbon material that is placed on the outside of the first layer (71). However, as stated by the Examiner, JP '501 lacks the disclosure of using an inorganic binder for binding the fibers to one another. Thus, EP '335 is cited to account for this deficiency of the primary reference.

The cited secondary reference of EP '335 discloses a filter for selecting and collecting a chlorinated organic compound contained in a fluid (from the fluid). The filter has a cylindrical molded body containing fibers and an inorganic binder for binding the fibers to one another.

However, EP '335 fails to disclose or suggest a hydrophobic material that is retained in the molded body. Similarly, JP '501 lacks disclosure of the claimed feature of the hydrophobic material within the molded body. Thus, there is no disclosure of all claimed features and a *prima facie* case of obviousness has not been established. *See In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). Accordingly, withdrawal of this rejection is respectfully requested for this reason alone.

Still, the Examiner states that it would have been obvious to one skilled in the art to modify the primary reference of JP '501 to include an inorganic binder (in place of cellulose or organic binder) for binding the fibers together, while referring to the description in EP '335 (see page 4, first paragraph of the Office Action). However, such a proposal is improper. When an inorganic binder of EP '335 is employed instead of cellulose or organic binder in the first layer (71) of JP '501, a filter thus obtained would be composed of a molded body having fibers bound by inorganic binder and an activated carbon material, namely a hydrophobic material. However, the thus obtained filter has the hydrophobic material as a form of a separate, second layer laminated on the outside of the first layer having the fibers and the inorganic binder. Therefore, the hydrophobic material cannot and is not retained in the first layer. This result is the same even if the second layer of JP '501 is placed on the inside of the first layer. In other words, the present invention is structurally distinct from the proposed combination of references, and the Examiner's proposed combination still does not equal the presently claimed invention.

In summary, and in contrast to JP '501 and EP '335, the hydrophobic material feature of the present invention is significant in that:

- a hydrophobic material is retained in a cylindrical molded body of fibers and inorganic binder which corresponds to the first layer achieved by the combination of JP '501 and EP '335; and
- the hydrophobic material is retained mainly in a direction of the inner circumferential side to the thickness direction of the cylindrical molded body.

Such unique points of the present invention are not mentioned or suggested in either one of JP '501 and EP '335. In addition, one of ordinary skill in the art would not modify the primary reference of JP '501 as explained above, such that the skilled artisan would not achieve the present invention. In other words, JP '501 cannot be properly modified in view of the EP '335 disclosure. In this regard, the requisite motivation is lacking when the Examiner's proposed modification or combination renders a reference unsatisfactory for its intended purpose. *See re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); *see also* M.P.E.P. § 2143.01. Furthermore, while patents are relevant as prior art for all they contain, they cannot be relied upon to teach embodiments that are not reasonably suggested to one having ordinary skill in the art. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804 (Fed. Cir. 1989).

In addition, while patents are relevant as prior art for all they contain, they cannot be relied upon to teach embodiments that are not reasonably suggested to one having ordinary skill in the art. *See Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir. 1989). Here, JP '501 cannot be interpreted so broadly such that the present invention could be achieved (e.g., the hydrophobic material cannot and is not retained in the first layer).

Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness since there is no disclosure of all claimed features, and/or the requisite motivation is lacking for the reasons stated above. *In re Vaeck; Gordon; Merck & Co.; supra*. Reconsideration and withdrawal of this rejection are respectfully requested.

Conclusion

A full and complete response has been made to all issues as cited in the Office Action.

Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: JAN 26 2007

Respectfully submitted,

By Ma
Mary Anne Armstrong
Registration No.: 40,069
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant

Attachments: Abstract
Substitute specification